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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,638	04/21/2004	James D. Shaffer	TARINFO.015C1	5323
27189	7590	10/19/2005		
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101			EXAMINER AVELLINO, JOSEPH E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,638

Applicant(s)

SHAFFER ET AL.

Examiner

Joseph E. Avellino

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 are presented for examination; claim 1 independent.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 of Patent no. 6,748,426 contains every element of claims 1-11 of the instant application and as such anticipates claims 1-11 of the instant application.

Claims 1-58 of Patent no. 5,901,214 contains every element of claims 1-11 of the instant application and as such anticipates claims 1-11 of the instant application.

Application no. 10/732,147 10/454,396, and Patent nos. 6,661,884, 6,608,892, 6,570,975, 6,385,312, 6,381,324, 6,185,290, 6,091,810, 6,058,179, 5,982,868, 5,956,397, 5,910,982, 5,907,608, 5,848,131, 5,506,897, all recite essentially the same claimed limitations of the instant application and as such all anticipate claims 1-11 of the instant application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman et al. (USPN 5,948,061) (cited by Applicant in IDS) (hereinafter Merriman).

5. Referring to claim 1, Merriman discloses a computerized information system for retrieving consumer data over a network, comprising:

a first information server (i.e. server housing advertising server process 19) for receiving a consumer identifier (i.e. IP address) from a consumer network interface device (i.e. client computer) (col. 5, lines 10-33);

a Linkage Key conversion module comprising instructions for converting the consumer Identifier into a Linkage Key (i.e. look up user IP address to retrieve identification number) (col. 5, lines 33-40);

a Linkage Key database comprising consumer data indexed by the Linkage Key (i.e. database containing all the information known about the user) (Figure 3A, col. 5, lines 33-62); and

instructions for comparing the Linkage Key to the linkage database in order to retrieve consumer data from the linkage database (col. 5, lines 50-63).

6. Referring to claim 2, Merriman discloses the consumer network interface device is a personal computer or PDA (col. 3, line 25).

7. Referring to claim 5, Merriman discloses the consumer identifier is an IP address (col. 5, lines 35-45).

8. Referring to claim 8, Merriman discloses the information server comprises an Internet server (Figure 1).

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9. Referring to claim 9, Merriman discloses the Internet server comprises instructions for writing the consumer identifier to a consumer's computer (i.e. the IP address is inherently transmitted to the destination in the return packet with the data) (col. 5, lines 10-60).

10. Referring to claim 10, Merriman discloses the Internet server writes a cookie data file to the consumer's computer (col. 5, lines 20-40).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 4, 6, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Shaffer et al. (USPN 5,901,214) (hereinafter Shaffer).

13. Referring to claims 3, 4, and 6, Merriman discloses the invention substantively as described in claim 1. Merriman does not specifically disclose the linkage key is a spatial key that defines a geographic location. In analogous art, Shaffer discloses another system for retrieving consumer data over a network which shows a linkage key as a spatial key which defines a geographic location (i.e. a zip code) (col. 11, lines 55-60). It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Shaffer since Merriman remains silent as to how a user identification is assigned to a user (col. 5, lines 10-30). This would lead one of ordinary skill in the art to search for other methods as to how a user can be identified in a database system, eventually finding the system of Shaffer and its novel use of linkage keys as zip codes (col. 1, line 30 to col. 12, line 25).

14. Referring to claim 7, Merriman discloses the invention as described in claim 1. Merriman does not specifically disclose the linkage key conversion module converts a consumer address into a US delivery point code. In analogous art, Shaffer discloses converting a consumer address (i.e. a consumer's telephone number) into a USDPC (col. 12, lines 45-60). It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Shaffer since Merriman remains silent as to how

a user identification is assigned to a user (col. 5, lines 10-30). This would lead one of ordinary skill in the art to search for other methods as to how a user can be identified in a database system, eventually finding the system of Shaffer and its novel use of linkage keys as zip codes (col. 1, line 30 to col. 12, line 25).

15. Referring to claim 11, Merriman discloses the invention substantively as described in claim 1. Merriman does not disclose the consumer data is household data, individual data, census data, business location data, financial data, product consumption scores, maps, directions, address, property data, environmental data and geography related data. In analogous art, Shaffer discloses the consumer data is household data, individual data, census data, business location data, financial data, product consumption scores, maps, directions, address, property data, environmental data and geography related data (Figure 1). It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Shaffer since Merriman remains silent as to how a user identification is assigned to a user (col. 5, lines 10-30). This would lead one of ordinary skill in the art to search for other methods as to how a user can be identified in a database system, eventually finding the system of Shaffer and its novel use of linkage keys as zip codes (col. 1, line 30 to col. 12, line 25).

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuznetsov (USPN 6,021,406).

17. Referring to claim 1, Kuznetsov discloses a computerized information system for retrieving consumer data over a network (e.g. abstract).

For a first information server... See col. 7, lines 20-63.

For a Linkage key conversion module... See col. 7, lines 35-45.

For a linkage key database... See col. 3 line 60 to col. 4, line 65.

For instructions for comparing... See col. 7, lines 25-35.

18. Claims 2-11 are either expressly taught by Kuznetsov or are inherent features of the system described.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Neville (USPN RE36,111).

19. Referring to claim 1, Neville discloses a computerized information system for retrieving consumer data over a network (e.g. abstract).

For a first information server... See abstract.

For a Linkage key conversion module... See col.11, lines 32-65.

For a linkage key database... See Figure 1.

For instructions for comparing... See col. 3, lines 25-40.

20. Claims 2-11 are either expressly taught by Neville or are inherent features of the system described.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaffer.

21. Referring to claim 1, Shaffer discloses a computerized information system for retrieving consumer data over a network (e.g. abstract).

For a first information server... See abstract.

For a Linkage key conversion module... See abstract.

For a linkage key database... See col. 12, lines 45-60.

For instructions for comparing... See col. 12, lines 45-60.

22. Claims 2-11 are either expressly taught by Shaffer or are inherent features of the system described.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

24. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

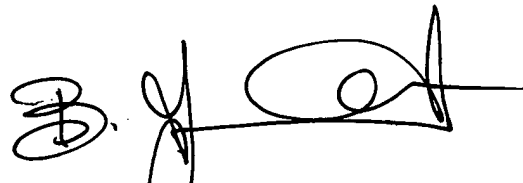
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEA
September 1, 2005



BUNJOB JAROENCHONWANIT
PRIMARY EXAMINER